



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/322,732 05/28/99 MAROTTI

K PUJ-0041

EXAMINER

026657 HM12/0921
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ROBINSON, H

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

09/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
09/322,732Applicant(s)
Marotti et al.Examiner
Hope RobinsonArt Unit
1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 4, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attached sheet.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-8, 15-18 and 140-141
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

Art Unit: 1653

DETAILED ACTION

1. Applicant's response to the Final Office Action mailed June 29, 2001 in Paper No. 15 on September 4, 2001 is acknowledged.

2. Applicant's arguments filed September 4, 2001 have been fully considered but are not persuasive.

The rejection under 35 U.S.C. 112, first paragraph over claims 1-8, 15-18 and 140-141 has been maintained.

The rejection under 35 U.S.C. 112, second paragraph over claims 1-8 and 15-18 has been maintained.

3. Claims 1-8, 15-18 and 141 have been amended. Claims 1-8, 15-18 and 140-141 are pending.

4. Claims 1-8, 15-18 and 140-141 remain rejected under 35 U.S.C. 112, first paragraph because the amendments to the claims was not sufficient to overcome this ground of rejection. Note for example that the amended claims now recite " a method for identifying a compound that increases or decreases the activity of prokaryotic efp comprising the steps of : (a) contacting efp with a compound; and (b) determining whether said compound modifies activity of efp". One of

Art Unit: 1653

skill in the art would have to engage in undue experimentation to first determine if the compound had the effect of an increase or decrease in the activity of efp and to figure out the specific activity that was affected. The office action mailed June 29, 2001 stated that one skilled in the art would not be able to practice the claimed invention commensurate in scope with the claims because the specification lacked guidance/direction as to how to determine whether the test compound increases/decreases (modulates) the activity of efp. Furthermore, the specification lacks exemplification of a specific assay to assay a specific compound. It is suggested that applicant cancel claims 1-3 and amend claim 4 to recite either increase or decrease, not both.

5. Claims 1-8 and 15-18 remain rejected under 35 U.S.C. 112, second paragraph because the amendments to the claims was not sufficient to overcome this ground of rejection. It is noted that claim 1 has been amended to now recite "increases or decreases" in lieu of "modulates", however, as the two activities are opposed, thus to make the claim definite, only one term should be recited in the claim. Further, claim 1 does not recite how to determine whether the compound modifies the activity of efp or what activity of efp or how the activity is modified (see also claim 6). It is suggested that applicant amend the claims as indicated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday and Wednesday-Friday from 9.00 am to 5.30 pm (EST).

Art Unit: 1653

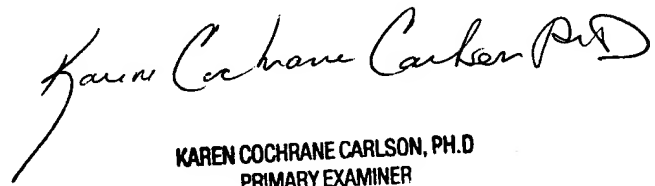
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low, Ph.D., can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope Robinson, MSH

Patent Examiner


KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER